

REMARKS

Claims 2, 4, 6, 8, 12-17, and 19-56 were pending in the present application.

The Examiner has:

- objected to claims 20 and 22,
- rejected claims 2, 6, 12-17, 22-27, 43 and 46-56, and
- allowed claims 4, 8, 19-21, 28-42, 44 and 45.

In the present paper:

- claims 6, 12-15, 20 and 22-27 are amended,
- no claims are canceled, and
- new claims 57-65 are added.

Consequently, claims 2, 4, 6, 8, 12-17, and 19-65 remain pending in the present application.

Reconsideration of the present application in light of the above amendments and the following remarks is respectfully requested.

Claim objections

The Examiner has objected to claims 20 and 22 for containing various informalities. However, it is believed that the present amendments to these claims overcome the Examiner's objections. Accordingly, Applicants respectfully request the Examiner withdraw the objections.

Rejections under 35 U.S.C. §102

Claim 6

Claim 6 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,050,121 to Garrett, et al. ("Garrett"). The PTO provides in MPEP §2131 that to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 6, Garrett must contain all of the above claimed elements of the claim.

However, Garrett does not disclose a wellbore casing apparatus, a solid wellbore casing member (including an external seal or otherwise), a perforated wellbore casing member (coupled

to a solid wellbore casing member or otherwise), a shoe coupled to a perforated wellbore casing member, a solid wellbore casing member having a portion that overlaps with a portion of a perforated wellbore casing member, or that the inside diameters of non-overlapping portions of solid and perforated wellbore casing members are equal, as recited in claim 6.

In contrast, the wellbore casing disclosed in Garrett appears to be substantially conventional in nature. Moreover, Garrett further discloses that an aspect of its invention is that the well need not even be cased, or can be only partially cased. Thus, Garrett fails to disclose the wellbore casing members recited in claim 6 of the present application, among other elements of the claim.

In rejecting claim 6 based on Garrett, the Examiner refers to Garrett's disclosure of a solid portion 11a of tubing string 11 that is joined to a lower, perforated portion 11b of the tubing string 11. However, those skilled in the art recognize that tubing string is different than wellbore casing, each serving entirely different purposes in the construction of and operation within a wellbore.

Consequently, the §102 rejection of claim 6 is not supported by Garrett. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Claim 12

Claim 12 was also rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,050,121 to Garrett, et al. ("Garrett"). As described above, the PTO provides in MPEP §2131 that to anticipate a claim, a reference must teach every element of the claim. Therefore, to sustain this rejection with respect to claim 12, Garrett must contain all of the above claimed elements of the claim. However, as also described above, Garrett does not disclose a wellbore casing, a first wellbore casing member, or a second wellbore casing member, among other elements recited in claim 12. Consequently, the §102 rejection of claim 12 is not supported by Garrett. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Claim 46

Claim 46 was rejected under 35 U.S.C. §102(e) as being anticipated by PCT WO 99/35368 to Lohbeck, et al. ("Lohbeck"). Among other requirements, §102(e) provides that a person shall be entitled to a patent unless the invention was described in a published PCT application only if the international application designated the United States. However, Lohbeck did not designate the United States. Therefore, Lohbeck cannot qualify as a §102(e) reference. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Additionally, Applicants note that Lohbeck also cannot qualify as a §102(b) reference because Lohbeck was published on July 15, 1999, which is not more than one year prior to February 23, 2000, the filing date of the present application.

Moreover, Applicants further note that Lohbeck also cannot qualify as a §102(a) reference because it was published on July 15, 1999, which is not before February 25, 1999, the priority date of the present application.

Rejections Under 35 U.S.C. §103Claims 2 and 43

Claims 2, 16, 17 and 43 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,957,195 to Bailey, et al. ("Bailey") in view of U.S. Patent No. 5,083,608 to Abdrakhmanov, et al. ("Abdrakhmanov"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claims 2 and 43.

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, in the context of claims 2 and 43, Bailey fails to teach a thin wall section of a tubular member that is adapted to radially expand and plastically deform from intimate contact with a thin wall section of a second tubular member upon radial expansion and plastic deformation of the second tubular member to form a mono-diameter wellbore casing, among other elements of claims 2 and 43. In contrast, Bailey merely teaches that the liner patch is radially expanded into contact with an existing liner, but fails to teach that, as a result of such expansion, the patch and the liner form a mono-diameter wellbore casing. That is, Bailey's apparatus achieves a multi-diameter wellbore casing, where the patched area of the casing has a smaller inner diameter than the non-patched area.

Moreover, Abdrakhmanov fails to cure this shortcoming of Bailey. In contrast, Abdrakhmanov also fails to teach a thin wall section of a tubular member that is adapted to radially expand and plastically deform from intimate contact with a thin wall section of a second tubular member upon radial expansion and plastic deformation of the second tubular member to form a mono-diameter wellbore casing, among other elements of claims 2 and 43. Moreover, even if Abdrakhmanov were to hypothetically cure the shortcomings of Bailey (which is clearly not the case here), the resulting combination would merely teach a patch constructed as described in Bailey but with the additional of an annular seal (31) between the discrete portions (501 and

502) of Bailey's liner patch 500, which is clearly different from the tubular members of the wellbore casing described in claims 2 and 43 of the present application.

Thus, even if Bailey and Abdrakhmanov are combined, they still fail to teach a thin wall section of a tubular member that is adapted to radially expand and plastically deform from intimate contact with a thin wall section of a second tubular member upon radial expansion and plastic deformation of the second tubular member to form a mono-diameter wellbore casing, among other elements of claims 2 and 43. Consequently, the combination of Bailey and Abdrakhmanov fails to support a *prima facie* case of obviousness of claims 2 and 43, and the explicit terms of §103 cannot be met. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

2. The Combination of References is Improper

Assuming, arguendo, that the above arguments for non-obviousness do not apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why Bailey and Abdrakhmanov cannot be applied to reject claims 2 and 43 under 35 U.S.C. §103.

That is, §2142 of the MPEP also provides:

...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Bailey nor Abdrakhmanov teaches, or even suggests, the desirability of the combination of a thin wall section of a tubular member that is adapted to radially expand and plastically deform from intimate contact with a thin wall section of a second tubular member upon radial expansion and plastic deformation of the second tubular member to form a mono-diameter wellbore casing, as specified above and as recited in claims 2 and 43.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. Here, because Bailey and Abdrakhmanov collectively fail to teach or suggest each and every element recited in claims 2 and 43, there cannot be any teaching, suggestion or incentive supporting the combination urged by the Examiner.

Moreover, even though the references are both directed towards some form of expansion, Bailey and Abdrakhmanov are incompatible systems that are not conducive to combination, whether with respect to the combination described by the Examiner or otherwise. That is, Abdrakhmanov describes a rotary expansion system, whereas Bailey describes a non-rotary expansion system. Those skilled in the art would readily realize that the material stresses/strains induced in the expansion members during expansion are quite different for rotary expansion systems relative to non-rotary expansion systems. Additionally, the impact forces and other metal-working forces required for operation of rotary expansion systems vary greatly from those required for operation of non-rotary expansion systems. Consequently, those skilled in the art of non-rotary expansion systems would not be motivated to look to Abdrakhmanov or any other reference describing a rotary expansion system when seeking to modify Bailey or any other non-rotary expansion system. Similarly, those skilled in the art of rotary expansion systems would not be motivated to look to Bailey or any other reference describing a non-rotary system when seeking to modify Abdrakhmanov or any other rotary expansion system. Thus, there exists no

motivation to combine Bailey and Abdrakhmanov, whether to arrive at the presently claimed subject matter or otherwise.

In view of the above, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there is no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 2 or 43. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Claim 46

Claims 53-56, which depend from claim 46, were rejected under 35 U.S.C. §103 as being unpatentable over Lohbeck in view of Bailey. However, as described above, Lohbeck is not prior art. Consequently, Lohbeck cannot be used to establish a *prima facie* case of obviousness with respect to claim 46 and, thus, its dependent claims. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

New Claims

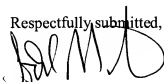
New claims 57-68 are also believed to be patentable over Garrett, Lohbeck, Bailey and Abdrakhmanov, whether taken separately or together, at least for reasons that are substantially similar to those described above with respect to the previously-pending claims.

Conclusion

All matters set forth in the Office Action have been addressed. Accordingly, it is believed that all claims are in condition for allowance. Favorable consideration and an early indication of allowability are respectfully requested.

Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



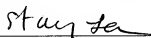
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